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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/703,503	10/31/2000	Anders Borgstrom	34650-569PT	2935

7590 11/26/2003

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EXAMINER

LE, DANH C

ART UNIT PAPER NUMBER

2683

DATE MAILED: 11/26/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/703,503

Applicant(s)

BORGSTROM ET AL.

Examiner

DANH C LE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,5-8,13-20,26,27,30 and 31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-8,13-20,26,27,30 and 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

- 1. Claims 1-3, 5, 6, 13-19, 26, 27, 30, 31 are rejected under 35 U.S.C. 102(e) as being anticipate by Kasabach (US 6,456,749).**

As to claim 1, Kasabach teaches a system for controlling an electronic device (figure 1), comprising:

an electronic device, said electronic device including a display screen (20);

a specially formatted surface (14) including a predefined address pattern and further including at least one field for use in performing a control function with respect to a display on the display screen of the electronic device; and

an electronic pen (12) for detecting a portion of the predefined address pattern to the electronic pen, wherein a position of the electronic pen on the specially formatted surface can be determined using the detected portion of the predefined address pattern, and wherein a position of the electronic pen with respect to the at least one field controls the display on the display screen of the electronic device (col.2, line 66-col.4, line 27).

As to claim 2, Kasabach teaches the system of claim 1, wherein the electronic device includes the electronic pen (12).

As to claim 3, Kasabach teaches the system of claim 1, wherein the electronic pen is separate from the electronic device (figure 1, 12).

As to claim 5, Kasabach teaches the system of claim 1, wherein the specially formatted surface comprises a paper, and wherein said at least one field comprises a plurality of fields for performing a plurality of control functions with respect to the display on the display screen of the electronic device (col.5, lines 52-col.6, line 4).

As to claim 6, Kasabach teaches the system of claim 1, wherein the specially formatted surface and the electronic pen comprise at least a portion of a man-machine interface for the electronic device (col.2, line 66-col.4, line 27).

As to claim 13, Kasabach teaches the system of claim 1, wherein the electronic includes a transmitter for communicating with the electronic device (figure 2, 18).

As to claim 14, Kasabach teaches the system of claim 13, wherein the transmitter transmits information to electronic device via at least one of a cable and a local wireless link (figure 2, 56)

As to claim 15, Kasabach teaches the system of claim 13, wherein the transmitter operates in accordance with Blue-tooth radio interface technology (col.8, lines 14-25).

As to claim 16, Kasabach teaches the system of claim 1, wherein the electronic device is selected from the group consisting of a mobile phone, a computer, a personal

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digital assistant, a calculator, a game console, a television, and a digital camera (col.5, lines 40-51).

As to claim 17, Kasabach teaches the system of claim 1, wherein the at least one field includes a field for providing the reading device with a joystick functionality (col.2, line 55-col.3, line 7).

As to claim 18, the claim is a method claim of claim 1; therefore, the claim is interpreted and rejected as forth in the claim 1.

As to claim 19, the claim is a method claim of claim 5; therefore, the claim is interpreted and rejected as forth in the claim 5.

As to claim 26, the claim is a method claim of claim 8; therefore, the claim is interpreted and rejected as forth in the claim 8.

As to claim 27, Kasabach teaches the method of claim 26, wherein the selection is detected by sensing a pressure on the reading device (figure 1, 34).

As to claims 30 and 31, Kasabach teaches the method of claim 18, further comprising the step of translating the at least one detected portion of the address pattern into a rotation angle and a tilt angle (col.4, line 58-col.5, line 9).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**2. Claims 7, 8 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kasabach in view of Merkel (US 5,739,810).**

As to claim 7, Kasabach teaches the system of claim 1, wherein the at least one field comprises a navigation field and wherein the display on the display screen. Kasabach fails to teach the displaying includes a cursor, wherein a position of the reading device with respect to the navigation field controls the position of the cursor on the display screen. Merkel teaches the displaying includes a cursor, wherein a position of the reading device with respect to the navigation field controls the position of the cursor on the display screen (col.3, lines 11-42). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Merkel into the system of Kasabach in order to control the position on the screen of the portable handwriting capture.

As to claim 8, the combine of Kasabach and Merkel teaches the system of claim 7, wherein a current position of the cursor is performed by a selection function (Merkel, col.3, lines 11-42), the selection function selected from the group consisting of a detection by the reading device of a portion of the address pattern within a selection field on the specially formatted surface, and a pressure sensitive detection on the reading device (col.4, lines 3-11 and col.5, lines 13-42).

As to claim 20, the claim is a method claim of claim 7; therefore, the claim is interpreted and rejected as forth in the claim 7.

***Conclusion***

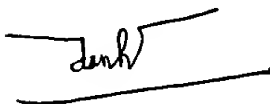
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A. Lapstun et al (US 6,627,870) the sensing device with interchangeable nibs.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANH C LE whose telephone number is 703-306-0542. The examiner can normally be reached on 8:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, WILLIAM TROST can be reached on 703-308-5318. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



Danh C. Le



WILLIAM TROST  
SUPERVISORY PATENT EXAMINER  
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